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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON,, VA 22209

EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,596

Applicant(s)

GANESAN ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-18-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12-18-03 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

The drawings are objected to because they are informal and some of the lettering is not legible making it difficult to read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 18 is objected to because the phrase “is initiated at after least one of” is grammatically incorrect. The Examiner suggests amending the phrase to read “is initiated after at least one.” Appropriate correction is required.

Claim Rejections - 35 USC § 101

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-7 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning. The Examiner suggests amending claims 1-7 to include some form of technology such as a computer, to overcome this rejection.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-7, 11, 23, 25, 27-35, 40, 52, 54, 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by the Randle et al. patent (US 6,594,647 B1).

The Randle patent discloses a method, system and associated article of manufacture for integrated event tracking of an electronic escrow transaction, comprising:

Receiving an instruction from a purchaser, via a network, to effect an electronic escrow transaction associated with a sale, made via the network, of goods or services from a seller (col. 7, lines 31-65),

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Directing at least one network communication with each of the purchaser, the seller and at least one financial institution in effecting the electronic escrow transaction (col. 7, lines 31-65), and

Storing a log of each communication, including the instruction, associated with the electronic escrow transaction (col. 4, lines 49-56),

A communications port (col. 3, lines 31-47),

A processor (col. 3, lines 31-47),

A memory (col. 4, lines 49-56, inherent in computer system with record archive),

A computer readable medium (col. 4, lines 49-56, inherent in computer system with record archive) (Claims 1, 28 and 57);

Initiating a debit from an account associated with the purchaser (col. 8, lines 41-51);

Storing an indication of the initiation of the debit from the purchaser account (col. 8, lines 41-51),

Initiating a credit to an account associated with the seller (col. 8, lines 41-51), and

Storing an indication of the initiation of the credit to the seller account (col. 8, lines 41-51) (Claims 2 and 29);

Initiating a debit from an account associated with a processing agent (col. 8, lines 41-51),
and

Storing an indication of the initiation of the debit from the processing agent account (col. 8, lines 41-51) (Claims 3, 30 and 31);

Initiating a credit to an account associated with the seller (col. 8, lines 41-51), and

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Storing an indication of the initiation of the credit to the seller account, wherein the credit to the seller account is a corresponding credit to the debit from the processing agent account (col. 8, lines 41-51) (Claims 4, 30 and 31);

Transmitting a notice, via the network, to the seller that funds from an account associated with the purchaser are available and that the seller should ship the goods to, or provide the service for, the purchaser (col. 9, lines 1-16), and

Storing an indication that the notice has been transmitted to the seller (Col. 9, lines 1-16) (Claims 5 and 33);

The notice is transmitted after at least one of (i) a predetermined period, beginning at initiation of a debit to an account associated with a purchaser, has elapsed, or (ii) funds from the purchaser account are credited to an account associated with a service provider (col. 9, lines 1-16) (Claims 6 and 34);

Receiving, via the network, a first notice of one of (i) the goods have been shipped, or (ii) the service having been performed (col. 9, lines 1-16),

Storing an indication that the first notice has been received (col. 9, lines 1-16),

Transmitting a second notice, via the network, to the purchaser that the seller has one of (i) shipped the goods to the purchaser, or (ii) performed the services for the purchaser (col. 9, lines 1-16), and

Storing an indication that the second notice has been transmitted to the purchaser (col. 9, lines 1-16), wherein the first notice is received from at least one of (i) a shipping agent, or (ii) the seller (col. 9, lines 1-16) (Claims 7 and 35);

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Receiving, via the network, a notice of one of (i) the goods have been shipped by the seller, or (ii) the service shaving been performed by the seller (col. 9, lines 1-16),

Initiating a credit to an account associated with the seller (col. 8, lines 41-51),

Storing an indication that the notice has been received (col. 8, lines 41-51), and

Storing an indication of the initiation of the credit to the seller account (col. 9, lines 1-16),

wherein the credit to the seller account is initiated after a predetermined period, beginning at receipt of the notice (col. 9, lines 1-16), and

wherein the notice is received from at least one of (i) the seller, or (ii) a shipping agent (col. 9, lines 1-16) (Claims 11 and 40);

Receiving the instruction via a web page generated subsequent to the purchaser selecting a hyper-link presented to the purchaser by an Internet web site selling goods or services (col. 9, lines 17-34),

Wherein the web page presented to the purchaser includes details of the sale (col. 9, lines 17-34) (Claims 23 and 52);

Retrieving any of the logged and stored communications (col. 9, lines 17-48) (Claims 25 and 54); and

The credit to the account associated with the seller is initiated after at least one of (i) a predetermined period, and (ii) beginning upon receipt of the first notice, has elapsed, or (ii) receipt of the second notice (col. 7, lines 56-65) (Claims 27 and 56).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 16, 19, 24, 36, 45, 48 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randle patent.

The first notice includes a delivery tracking number (the Examiner takes Official Notice that it is common when shipping goods to give a tracking number so the item can be traced) (claims 8, 16, 36 and 45);

The goods or services are purchased from an Internet auction (the Examiner takes Official Notice that it is commonly known goods and services can be purchased over the Internet and/or through an auction) (Claims 19 and 48); and

The stored logged communications include an indication of the date and time each communication is received or transmitted (Randle, col. 4, lines 49-56 record, the Examiner takes Official Notice that it is commonly known that when electronic records are recorded the time and date of communications is recorded) (Claims 24 and 53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Randle invention to include the limitations the Examiner has taken Official Notice of so as to provide a more thorough tracking systems and expand the use of the system to include Internet auctions so as to provide the services to a greater variety of people.

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Claims 9, 10, 12, 13, 26, 37, 38, 39, 41, 42, 49 and 55 are rejected under 35

U.S.C. 103(a) as being unpatentable over Randle patent as stated above and further in view of the Tozzoli patent (US 6,151,588).

The Randle patent teaches the claimed invention, as stated above, except for the following which is taught by the Tozzoli patent:

Receiving, via the network, a notice of one of (i) goods having been received from the seller and being acceptable, or (ii) the services having been acceptably performed by the seller (Tozzoli, col. 17, lines 5-20), and

Storing an indication that the notice has been received, wherein the notice is received from at least one of (i) the seller, (ii) a shipping agent, or (iii) the purchaser (Tozzoli, col. 17, lines 5-20) (Claims 9 and 38);

Initiating a credit to an account associated with the seller (Tozzoli, col. 17, lines 21-30), and

Storing an indication that the notice has been received, wherein the notice is received from at least one of (i) the seller, (ii) a shipping agent, or (iii) the purchaser (Tozzoli, col. 17, lines 21-30) (Claims 10 and 39);

Receiving, via the network, a notice of one of (i) the goods having been received from the seller and being unacceptable, (ii) the good having not been received from the seller, (iii) the service having not been received from the seller, or (iv) the services having not been performed by the seller (Tozzoli, col. 17, lines 5-20), and

Storing an indication that the notice has been received (Tozzoli, col. 17, lines 5-20) (Claims 12 and 41);

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The notice includes a notice to suspend a pending credit to an account associated with a seller (Tozzoli, col. 17, lines 35-40) (Claims 13 and 42); and

Receiving, from a shipping agent, a first notice that goods have been delivered to the purchaser (Tozzoli, col. 17, lines 5-40),

Storing an indication that the first notice has been received (Tozzoli, col. 17, lines 5-40),

Receiving, from the purchaser, a second notice that the delivered goods are acceptable (Tozzoli, col. 17, lines 5-40),

Storing an indication that the second notice has been received (Tozzoli, col. 17, lines 5-40), and

Initiating a credit to an account associated with the seller (Tozzoli, col. 17, lines 5-40) (Claims 26 and 55); and

The first notice includes is transmitted by at least one of (i) the seller, or (ii) the shipping agent (Tozzoli, col. 17, lines 5-40) (Claim 37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Randle system with the teachings of the Tozzoli patent so as to provide a more user-friendly, accommodating commerce system.

Claims 14, 15, 17, 18, 20, 21, 22, 43, 44, 46, 47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randle patent as stated above and further in view of the Junger patent (US 6,085,172).

The Randle patent discloses the claimed invention, as stated above, except for the following which is taught by the Junger patent:

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The notice includes a notice to reverse a debit to an account associated with the purchaser (Junger, col. 8, lines 58-67, the reverse debit is inherent when the credit is given for the returned property, it is also known in the credit card industry that when an item is returned, the credit card is debited the amount of the returned item) (Claims 14 and 43);

Receiving, via the network, a first notice that the goods have been returned shipped to the seller (Junger, col. 4, lines 7-20),

Storing an indication that the first notice has been received (Junger, col. 4, lines 7-20),

Transmitting to the seller, via the network, a second notice that the goods have been returned shipped from the purchaser (Junger, col. 5, lines 5-23), and

Storing an indication that the second notice has been transmitted to the seller (Junger, col. 5, lines 36-50),

Wherein the first notice is received from at least one of (i) the purchaser, and (ii) a shipping agent (Junger, col. 4, lines 7-20) (Claims 15 and 44);

Receiving, via the network, a third notice that the goods have been received by the seller (Junger, col. 6, line 58 through col. 7, line 6), and

Storing an indication that the third notice has been received (Junger, col. 6, line 58 through col. 7, line 6),

Wherein the third notice is received from at least one of (i) the seller, and (ii) the shipping agent (Junger, col. 6, line 58 through col. 7, line 6) (Claims 17 and 46);

Initiating a credit to an account associated with the purchaser (Junger, col. 8, lines 58-67),
and

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Storing an indication of the initiation of the credit to the purchaser account (Junger, col. 8, lines 58-67),

Wherein the credit to the purchaser account is initiated after at least one of (i) upon receipt of a notice, via the network, from at least one of the seller or shipping agent, that the goods have been delivered to the seller, or (ii) after a predetermined period, beginning at a notification to the seller that the purchaser has shipped the goods to the seller, has elapsed (Junger, col. 8, lines 58-67) (Claims 18 and 47);

Initiating a debit from an account associated with the purchaser (Junger, col. 17, lines 5-30),

Initiating a credit to an escrow account associated with a processing agent (Junger, col. 17, lines 5-30),

Initiating a debit to the escrow account associated with the processing agent (Junger, col. 17, lines 5-30),

Initiating a credit to an account associated with the seller (Junger, col. 17, lines 5-30),

Storing an indication of the initiation of the debit to the purchaser account (Junger, col. 17, lines 5-30), and

Storing an indication of the initiation of the credit to the seller account (Junger, col. 17, lines 5-30) (Claims 20 and 49);

The credit to the escrow account is a corresponding credit to the debit from the purchaser (Randle, col. 7, lines 60-65) (Claims 21 and 50); and

The credit to the seller account is a corresponding credit to the debit from the escrow account (Randle, col. 7, lines 60-65) (Claims 22 and 51).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Randle system with the teachings of the Junger patent so as to provide a more user-friendly, accommodating commerce system that would allow for items to be returned.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Pieterse, Pollin, Ishikawa, O'Leary, Gross, Bissonette, McKeen, Johnson, Cotton, Polk and Landry references are all directed to various types of electronic payment systems. The Junger patent is directed to a system for handling returned products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600